

REMARKS**I. OBJECTION TO CLAIMS**

Claims 6 and 14-16 stand objected to under 37 C.F.R. 1.75(c) as being in improper form. Applicants' representative contacted the Examiner in order to obtain clarification as to the basis for this objection. The Examiner indicated that the dependency recitation "according to claim 1, 2, 3, 4, or 5" could be interpreted as claim 1 and 2 and 3 and 4 OR 5, which would be an improper non-alternative format. However, it is respectfully submitted the Examiner's interpretation is grammatically incorrect. MPEP § 608.01(n) cites an example similar to that recited in claims 6-8 and 14-16 as being a proper multiple dependent claim. The Examiner requested that Applicants cite the example from the MPEP whereby he would withdraw the objection. Accordingly, attached hereto is a copy of the pertinent MPEP section evidencing that claims 6-8 and 14-16 are in proper format. Based on the foregoing, it is respectfully requested that the objection to claims 6 and 14-16 under 37 C.F.R. 1.75(c) be withdrawn.

II. CLAIMS 1, 7 AND 9 ARE PATENTABLE OVER CRISP IN VIEW OF KIM

Claims 1, 7 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Kim. In order to expedite prosecution, claims 1 and 9 have been amended to include the limitation of claim 8. Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Kim and Paterson et al. ("Paterson"). This rejection is respectfully traversed for the following reasons.

With respect to claim 8, the Examiner alleges on page 8, lines 1-7 of the outstanding Office Action that the various references *individually* disclose automatically

responding to an incoming call. As a preliminary matter, it is respectfully submitted that the Examiner's reference to Phillips and Ulveland is irrelevant to the pending rejection as they have not been relied on as part of the proposed combination in accordance with the specific requirements under § 103 related to the requisite motivation/rationale, etc., for making modifications of prior art. Nevertheless, it is submitted that the cited prior art does not suggest claims 1 and 9, as amended.

For example, the Examiner admits that Crisp does not disclose an automatic responding method but alleges that "Paterson [discloses an] automatic responding method for answering of incoming call without touching the wireless telephone" However, Paterson does not appear to disclose changing from a manual responding method to an *automatic* responding method. The Examiner appears to interpret the responding method "without touching the wireless telephone" as inherently automatic. In contrast, Paterson expressly discloses that the "headset user [can] answer incoming calls ... while *touching* only the headset" (*see* lines 15-18 of the Abstract). Indeed, Paterson appears to suggest a *manual* switch for answering incoming calls (*see* col. 3, lines 24-35). Accordingly, though Paterson appears to suggest answering calls without touching the handset, Paterson does not appear to suggest answering calls without touching the headset and instead appears to suggest *manual* operation of a *headset* switch (*see, e.g.,* element 119) for answering incoming calls. It should be noted that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999).

Furthermore, even assuming *arguendo* that Paterson suggested an automatic responding method, such automatic responding method would be based on the headset condition and NOT the flip-lid condition. Accordingly, the device resulting from the

proposed combination does not suggest changing the responding method from manual to automatic "when opening the *flip-lid* is determined" (emphasis added).

In particular, Crisp/Kim disclose changing between two manual responding methods (i.e., using different keys and speakers, respectively) in response to the condition of the *flip-lid* covering the respective phones of Crisp/Kim. In contrast, the alleged automatic responding method of Paterson operates in response to *headset* detection. Accordingly, the headset detection circuit of the device resulting from the proposed combination would function *independently* of the flip-lid detection circuit, so that the manual responding method would NOT be changed to automatic in response to the *flip lid* condition. Rather, the head-set detection circuit would provide a *separate* automatic responding method while the flip-lid detection circuit would continue to change between the two *manual* responding methods of Crisp/Kim.

The cited prior art does not suggest changing from a manual to an automatic responding method based on the flip-lid condition, and there is no suggestion in the cited prior art for functionally/structurally interrelating the alleged automatic response mechanism of the headset of Paterson with the manual response mechanism of the flip-lid of Crisp/Kim.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 1 and 9 as amended because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1 and 9 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on all the foregoing, it is submitted that claims 1, 7 and 9 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 1, 7 and 9 under 35 U.S.C. § 103 over Crisp in view of Kim be withdrawn.

III. CLAIMS 2 AND 10 ARE PATENTABLE OVER CRISP IN VIEW OF PHILLIPS

Claims 2 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Phillips. This rejection is respectfully traversed for the following reasons.

The Examiner admits that Crisp does not disclose an antenna state detecting circuit and therefore relies on Phillips to modify Crisp in an attempt to reach the claimed invention. However, with respect to Phillips, it is respectfully submitted that the antenna position sensing circuitry is used to activate or deactivate the functionality of the phone rather than *change the responding method*.

For example, although it appears that extending the antenna can be used to automatically answer the phone (*see* col. 4, lines 1-7; col. 6, lines 55-58), such operation does not *change* one responding method to another but rather, merely *activates* a single responding method. It is respectfully submitted that the inactive state of Phillips when the antenna is not extended can not reasonably be interpreted as a responding method, so that activation thereof would NOT be a change in a responding method.

In order to clarify this distinction, claims 2 and 10 have been amended to define changing from a first responding method to a second responding method, whereas the inactive state of Phillips is a NON-responding method rather than a first/second responding method.

The Examiner is again directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 2 and 10 as amended because the proposed combination fails the "all the claim limitations" standard required under § 103.

Based on all the foregoing, it is submitted that claims 2 and 10 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 2 and 10 under 35 U.S.C. § 103 over Crisp in view of Phillips be withdrawn.

IV. CLAIMS 3 AND 11 ARE PATENTABLE OVER CRISP IN VIEW OF KIM AND PATERSON

Claims 3 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Kim and Paterson. This rejection is respectfully traversed for the following reasons.

The Examiner admits that Crisp/Kim does not disclose a plug and therefore relies on Paterson to modify Crisp in an attempt to reach the claimed invention. However, even assuming *arguendo* that using a flip-lid state detecting circuit and plug detecting circuit are *individually* known, the cited prior art does not suggest the *combination* thereof. Claims 3 and 11 embody changing the responding method when "opening the flip-lid *and* [(rather than OR)] putting the plug are determined" so that the claims expressly define a functional interrelationship between the states of the flip-lid and plug. As the Examiner relies on separate references for allegedly disclosing the structurally distinct flip-lid and plug detecting circuits individually, even assuming the proposed combination is proper, no such functional interrelationship is suggested by the cited prior art.

It is submitted that the proposed combination is improper because the Examiner has not provided the requisite *objective* evidence *from the prior art* that "suggests the desirability" of the proposed combination. As is well known in patent law, a *prima facie* showing of obviousness can only be established if the prior art "suggests the desirability" of the proposed combination using objective evidence. The Examiner is directed to MPEP § 2143.01 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that Crisp can be modified by Paterson, it is submitted that the "mere fact that [Crisp and Paterson] can be combined ... does not render the resultant combination obvious" because nowhere does the *prior art* "suggest the desirability of the combination" as set forth by the Examiner.

The Examiner is further directed to MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the instant case, even assuming *arguendo* that Crisp and Paterson "teach that all aspects of the claimed invention [are] individually known in the art", it is submitted that such a conclusion "is not sufficient to establish a *prima facie* case of obviousness" because there is no *objective* reason on the record to combine the teachings of the cited prior art. In contrast, Crisp and Paterson are completely silent as to suggesting the *combination* of changing a responding method based on the condition of *both* the flip-lid *and* the plug.

It is submitted that patentable subject matter typically arises from using *known* elements in novel *combinations*. Accordingly, the Examiner's allegation that changing a

responding method based on the condition of the flip-lid OR the plug is well-known *separately* is irrelevant to the determination of patentability for the *combination* thereof. At best, the Examiner has attempted to show only that the elements (i.e., flip-lid and plug) of the claimed invention are *individually* known without providing a *prima facie* showing of obviousness that the *combination* of elements recited in the claims is known or suggested in the art.

Based on all the foregoing, it is submitted that claims 3 and 11 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 3 and 11 under 35 U.S.C. § 103 over Crisp in view of Kim and Paterson be withdrawn.

V. CLAIMS 4, 5, 12 AND 13 ARE PATENTABLE OVER CRISP IN VIEW OF PHILLIPS AND PATERSON

Claims 4 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Phillips and Paterson, and claims 5 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Paterson and Phillips. These rejections are respectfully traversed for reasons similar to those discussed above with respect to claims 2 and 10 regarding the antenna. Further, similarly to claims 3 and 11, claims 4, 5, 12 and 13 each embody functionally interrelated detecting circuits in *combination* whereas the proposed combinations merely, at best, suggest that the circuits are *individually* known.

Based on all the foregoing, it is submitted that claims 4, 5, 12 and 13 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 4, 5, 12 and 13 under 35 U.S.C. § 103 over Crisp in view of Phillips/Paterson be withdrawn.

VI. CLAIMS 6 AND 14-16 ARE PATENTABLE OVER CRISP IN VIEW OF PHILLIPS AND PATERSON

Claims 6 and 14-16 stand rejected under 35 U.S.C. § 103 over Crisp in view of Kim and Ulveland. This rejection is respectfully traversed for the following reasons.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplicatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1-5 and 9-13 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, claim 16 is independently patentable for reasons similar to those discussed above with respect to claim 8. Further, with respect to claims 6 and 14, it is respectfully submitted that the proposed combination does not disclose the timer/process recited therein. The Examiner reads the answer delay time taught by Ulveland for previewing a call before answering it, as equivalent to the timer/process recited in claims 6 and 14. However, the timer/process of the present invention can *release* the *changed* responding method so as to enable, for example, return to the original responding method. Accordingly, the present invention can allow the default responding method to be automatically reset after it was changed in response to the detected result (e.g., flip-lid, antenna, etc.).

In contrast, Ulveland simply discloses providing a delay *before activating* an original responding method (which has never been changed or released). The delay of Ulveland thereby serves to pause the response rather than change the responding method.

As such, it is respectfully submitted that the time delay of Ulveland is unrelated to the timer/process of the present invention. Accordingly, even assuming *arguendo* proper, it is respectfully submitted the proposed combination does not disclose or suggest the combination recited in claims 6 and 14.

Based on all the foregoing, it is submitted that claims 6 and 14-16 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 6 and 14-16 under 35 U.S.C. § 103 over Crisp in view of Kim and Ulveland be withdrawn.

VII. CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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APPENDIX

1. (Amended) A portable telephone apparatus having a flip-lid, said portable telephone apparatus comprising:

a radio circuit section for transmitting and receiving a signal to/from a radio base station;

a radio control circuit section for controlling said radio circuit section; and

a flip-lid state detecting circuit for detecting an opening/closing state of the flip-lid,

wherein said radio control circuit section changes a responding method for responding to an incoming call from a manual responding method that requires a certain operation to an automatic responding method that requires no operation when opening the flip-lid is determined based on a detection result by said flip-lid state detecting circuit.

2. (Amended) A portable telephone apparatus having an extensible antenna that is freely loaded and unloaded in a case, said portable telephone apparatus comprising:

a radio circuit section for transmitting and receiving a signal to/from a radio base station;

a radio control circuit section for controlling said radio circuit section; and

an antenna state detecting circuit for detecting an extension/contraction state of the extensible antenna,

wherein said radio control circuit section changes a responding method for responding to an incoming call from a first responding method to a second responding

method when extending the extensible antenna is determined based on a detection result by said antenna state detecting circuit.

4. (Amended) A portable telephone apparatus having an extensible antenna that is freely loaded and unloaded in a case and an earphone jack, said portable telephone apparatus comprising:

a radio circuit section for transmitting or receiving a signal to/from a radio base station;

a radio control circuit section for controlling said radio circuit section;

an antenna state detecting circuit for detecting an extension/contraction state of the antenna; and

a plug detecting circuit for detecting an a state of putting a plug into the earphone jack, wherein said radio control circuit section changes a responding method for responding to an incoming call when extending the extensible antenna and putting the plug are determined based on detection results by said antenna state detecting circuit and said plug detecting circuit[.].

6. (Amended) The portable telephone apparatus according to [claims] claim 1, 2, 3, 4, or 5, further comprising a timer used for releasing the changed responding method after a predetermined time.

7. (Amended) The portable telephone apparatus according to [one of] claim 1, 2, 3, 4, or 5, wherein said radio control circuit section changes the responding method for

responding to the incoming call from pressing a predetermined specific key to pressing a plurality of predetermined keys.

8. (Amended) The portable telephone apparatus according to [one of] claim [1,] 2, 3, 4, or 5, wherein said radio control circuit section changes the responding method for responding to the incoming call from a manual responding method that requires a certain operation to an automatic responding method that requires no operation.

9. (Amended) A changing method of a responding method of a portable telephone apparatus having a flip-lid, said changing method comprising the steps of:

determining an opening/closing state of the flip-lid; and

changing the responding method for responding to an incoming call from a manual responding method that requires a certain operation to an automatic responding method that requires no operation when opening the flip-lid is determined.

10. (Amended) A changing method of a responding method of a portable telephone apparatus having an extensible antenna that is freely loaded and unloaded in a case, said changing method comprising the steps of:

determining a extension/contraction state of the extensible antenna; and

changing the responding method for responding to an incoming call from a first responding method to a second responding method when extending the extensible antenna is determined.

14. (Amended) A changing method according to claim 9, 10, 11, 12, or 13 [further] further comprising the step of releasing the changed responding method after a set time in a timer.

16. (Amended) A changing method according to claim [9,] 10, 11, 12, or 13, wherein the responding method is changed from a manual responding method that requires a certain operation to an automatic responding method that requires no operation.